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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,729	03/18/2004	Dana Marie Walker	100041-41193	6036
7590 MARK P. LEVY, ESQ. THOMPSON.HINE LLP 2000 COURTHOUSE PLAZA NE 10 W. SECOND STREET DAYTON, OH 45402-1758		EXAMINER ROSS, DANA		
		ART UNIT 3722	PAPER NUMBER	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/01/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/803,729	WALKER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Dana Ross	3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 12 December 2005.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-38 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-38 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 18 March 2004 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-4, 7-14, 16-22, 25-32 and 34-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Attachment A ("A") or Attachment B ("B") in view of Lang ('426).

A or B discloses a front cover having a plurality of openings located generally adjacent to a binding edge of the front cover; a back cover having a plurality of openings located generally adjacent to a binding edge of the back cover; a plurality of sheets of paper each having a plurality of openings located generally adjacent to a binding edge thereof; a twin-wire binding having a plurality of turns, wherein each of the plurality of openings of the front cover, the back cover, and the plurality of sheets of paper receives a turn of the binding therethrough to bind said front cover, the back cover, and the plurality of sheets of paper together; and a binding guard having a first edge and a second edge, wherein the first edge is fixedly attached to the front cover generally adjacent to the binding edge of the front cover and the second edge is fixedly attached to the back cover generally adjacent to the binding edge of the back cover such that the guard generally covers an exposed portion of the binding.

A or B discloses the claimed invention except for explicitly disclosing the binding being generally a helical binding coil.

Lang discloses a spiral-bound or helical-coil bound scuba checklist (see figures 1 and 2). Lang discloses that "Spiral binding is a very popular, well-known, conventional binding system, commonly used in situations in which the binding is meant to be permanent, without the need to add additional pages at a later date." (see [0036]). Lang teaches that helical-coil binding is an equivalent structure known in the art. Therefore, because these two binding methods were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute helical-coil binding for twin-wire binding.

Regarding claim 2, A or B, as modified by Lang, disclose the coil bound notebook wherein the front cover, the back cover, and the plurality of sheets of paper are each generally rectangular in front view and are generally aligned.

Regarding claim 3, A or B, as modified by Lang, disclose the coil bound notebook wherein each of the front cover, back cover, and plurality of sheets of paper include a free edge oriented generally parallel to the associated binding edge and located on an opposite side thereof.

Regarding claims 4 and 22, A or B, as modified by Lang, discloses the claimed invention except for the sheets of paper being cellulose-based material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any required material for the sheet of paper, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice. *In re Leshin*, 125 USPQ 416.

Regarding claim 7, A or B, as modified by Lang, disclose the coil bound notebook wherein the plurality of openings on the front cover, the back cover, and the plurality of sheets of

paper each include at least ten openings arranged generally linearly to form a line that is generally parallel to, and extends along, the associated binding edge.

Regarding claim 8, A or B, as modified by Lang, disclose the coil bound notebook wherein each opening of one of the front cover, back cover, or plurality of sheets of paper are spaced from one another by a uniform distance.

Regarding claim 9, A or B, as modified by Lang, disclose the coil bound notebook wherein the wire guard is attached to front cover and the back cover by stitches extending through the wire guard and at least partially through the associated one of the front or back cover.

Regarding claim 10, A or B, as modified by Lang, disclose the coil bound notebook wherein the notebook is moveable to a closed position such that the front cover and the back cover are generally parallel and facing each other and wherein the plurality of sheets of paper are located therebetween.

Regarding claim 11, A or B, as modified by Lang, disclose the coil bound notebook wherein the wire guard is pulled tight against the helical binding coil when the notebook is in the closed position.

Regarding claim 12, A or B, as modified by Lang, disclose the coil bound notebook of claim 1 wherein the front cover and the back cover each have at least one of a thickness or stiffness that is greater than a sheet of said plurality of sheets of paper.

Regarding claim 13, A or B, as modified by Lang, disclose the coil bound notebook wherein the wire guard extends generally an entire length of the binding edge of the front cover and the back cover.

Regarding claim 14, A or B, as modified by Lang, disclose the coil bound notebook wherein the wire guard is generally flexible.

Regarding claim 16, A or B, as modified by Lang, disclose the coil bound notebook wherein the binding coil is a generally continuous single element formed in a helical shape.

Regarding claim 17, A or B, as modified by Lang, disclose the coil bound notebook wherein the first edge and the second edge of the wire guard are generally not visible when the notebook is in a closed position such that the front cover and back cover are generally parallel and facing each other with the plurality of sheets located between to provide a hidden seam.

Regarding claims 18-21, 25-32 and 34-38, the method for making a notebook is inherently disclosed in the above rejections. Regarding the back cover being positioned between the plurality of sheets of paper and the front cover and the coil guard being positioned between the front cover and the back cover, the back cover of either A or B would be positioned between the plurality of sheets of paper and the front cover when the front cover is rotated at an angle counterclockwise to the back cover and rests on the back surface of the back cover and the sheets of paper rest on the top surface of the back cover with the coil guard being positioned between the front and back covers.

3. Claims 5, 6, 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over A or B in view of Lang and further in view of Dorsey ('624).

A or B, as modified by Lang, discloses the claimed invention except for the sheets of paper including a tear guide line extending generally parallel to the binding edge and holes being located generally adjacent to the binding edge and located generally inwardly of the tear guide line.

Dorsey discloses a notebook having perforations (12a, 12b, 12c) in the front cover (4), rear cover (6) and individual pages (9) spaced from the binding means (10), wherein the pages have holes located generally adjacent the bidding edge inwardly of the perforations (see figure 2). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the sheets of paper of A or B to include perforations, as taught by Dorsey, to enable the sheets of paper to be torn away from the notebook and discarded or used separately from the notebook.

4. Claims 15 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over A or B in view of Lang and further in view of Su ('771).

A or B, as modified by Lang, discloses the claimed invention except for the notebook having a loop shaped to receive a writing instrument.

Su discloses a loose leaf-binding device having a loop (35) attached to the back cover (30) of the notebook for receiving a writing instrument (40a). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the notebook of A or B to include a loop for receiving a writing instrument, as taught by Su, to include a writing instrument integral with the notebook.

#### *Response to Arguments*

5. Applicant's arguments and Declaration filed 12 December 2005 have been fully considered but they are not persuasive.

Applicant asserts that "twin-wire binding mechanisms and helical coil binding mechanisms are not obvious variations due to, among other things, the manufacturing obstacles associated with helical coil binding mechanisms."

Examiner notes that the manufacturing process or apparatus for manufacture is not the subject of Applicant's invention. As stated above and in the previous office action, "Lange discloses a spiral-bound or helical-bound scuba checklist" and that helical-coil binding is an equivalent structure known in the art and are art-recognized equivalents.

Lange is cited to show that it is well known in the art to use a functional equivalent of a helical coil or a spiral bound.

Examiner notes that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims.

Examiner notes that Applicant's arguments are more directed towards the novelty of the inventiveness of the manufacturing process rather than to the actual structure of Applicant's invention.

Examiner recommends defining the claim limitations such that the structure of Applicant's invention states the positive limitations over the prior art.

### *Conclusion*

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

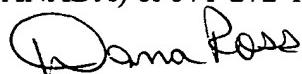
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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dana Ross whose telephone number is 571-272-4480. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica Carter can be reached on 571-272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Dana Ross  
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Art Unit 3722



dmr